

REMARKS

Claim 2 stands rejected under 35 USC 112, second paragraph, as indefinite. The Examiner has remarked that in line 3 "the extension lacks sufficient antecedent basis in the claim". The rejection is respectfully traversed.

Claim 2 recites:

"The pallet changer according to claim 1, wherein said table or pallet mount extends perpendicular to said spindle axis wherein said pallet support member is arranged in the extension of said table or said pallet mount in the horizontal direction ..."

Claim 2, at line 1 expressly recites that the element [table or pallet mount] extends perpendicular to the spindle axis. To one of ordinary skill "extension" can have somewhat different meanings depending upon how it [the word] is used. In the context of the present claims 1 and 2 "extension" is used as the "state of being", or the "range", or the "property of the body by which it occupies space". See dictionary.com. It is not used as something which is an "addition", i.e., a portion of the element which goes beyond the previous normal size, such as an extension on a house, or an extendable wand having segments which extend beyond the previous segment.

It is well established law the "the" is the equivalent of "said" in patent claiming. It is clear to one of ordinary skill that "table/pallet mount extends perpendicular", in line 2 of claim 2, provides adequate antecedence for the terminology "the [said] extension of said table/pallet mount", in line 3 of claim 2.

The Commissioner has promulgated that a claim is indefinite when it contains words or phrases whose meaning is unclear. With respect to antecedence, a lack of clarity arises when a claim refers to an element or limitation, and that element or limitation has not previously been recited; and/or where it is unclear as to what element the limitation is making reference. See M.P.E.P. 2173.05(e).

However, a "rote" recitation of previous language is not necessary, and the absence thereof does not render a claim indefinite. If the scope of a claim would be reasonably ascertainable by those skilled in the art, then the claim is not indefinite. See *Energizer Holdings, Inc. v. Int'l Trade Comm'n*, 435 F.3rd 1366, 77 USPQ2d 1625 (Fed. Cir. 2006); and *Ex parte Porter*, 25 USPQ 1144 (Bd. Pat. App. & Inter, 1992).

Claim 2 stands further rejected under 35 USC 112, second paragraph, regarding claim 2, lines 4-5. The Examiner has asked how many "pallet mounting surfaces" are being set forth, i.e., whether the pallet support member vertical mounting surfaces each include a pallet mounting surface. Further, regarding line 5 the Examiner has asked whether "a pallet mounting surface" is different from the pallet mounting surfaces previously recited.

Claim 2, lines 4-5 is being amended to overcome this further rejection, and to clarify the language of claim 2 consistent with the language of claim 1. To this end, the language of lines 4- 5 of claim 2 has been amended to recite: "*said pallet support member vertical pallet mounting surfaces each include a said pallet mounting surface*". In addition the wording "*of said pallet mount*" has been deleted from the end of claim 2 as it was redundant.

Claims 1- 2 stand rejected under 35 USC 102(f) as anticipated by Ota (US publication 2006/0260907). The Examiner has alleged that Ota teaches every limitation of each of the present claims.

Applicant filed a Terminal Disclaimer claiming that both inventions were owned by the same entity, Makino Milling Machine Co., LTD. The Examiner has remarked that the Terminal Disclaimer on file did not state that at the time the claimed invention was made, the two were owned by the same entity or subject to an obligation of assignment to the same entity.

Applicant is filing herewith a "Substitute Terminal Disclaimer" in which the further

averment is made:

"At the time the claimed invention was made the two inventions were owned by owner or subject to an obligation of Assignment. Said Assignments are recorded at REEL/FRAME 018125/0898 and 017543/0889."

The Examiner has further remarked that even after said Substitute Terminal Disclaimer with said recited averment is filed, the anticipation rejection under 35 USC 102(f) should remain and should not be precluded by 35 USC 103(c). In this regard, the Examiner has remarked that while subject matter which "qualifies as prior art" under 35 USC 102 (e) or (f) or (g) is precluded from being applied under §103 to support an obviousness rejection, it is not precluded from being applied under §102 to support an anticipation rejection.

Applicant sees no need to address these remarks as a §103 rejection has never been addressed with respect to the Ota reference.

Applicant traverses the standing rejection of claims 1- 2 under 35 USC 102(f) as anticipated by Ota for the following reasons:

- (1) The presently claimed invention by applicant is a different invention from the invention claimed by Ota. Applicant claims "A pallet changer ...". The reference Ota claims "A machine tool facility ...".
- (2) Both inventions are owned by the same entity, Makino Milling Machine Tool Co., Ltd, with assignments duly recorded to both inventions at REEL/FRAME 018125/0898 and REEL/FRAME 017543/0889, respectively; and a terminal disclaimer has been duly filed.
- (3) Both patent applications to applicant's invention and to the Ota invention have the same priority date of December 3, 2004. Both priority dates arise from International Applications filed in the Japanese Receiving Office on the same day.

There is no evidence to substantiate that the Ota invention was "made" under U.S. Patent Law before applicant's invention was made. Likewise there is no evidence that applicant's invention was made before the Ota invention. Therefore, each application is precluded from being used as a reference against the other.

Claims 1- 2 stand rejected under 35 USC 102(b) as anticipated by Geiger et al. (WO 2002/00388 relying upon the English equivalent US 6826821). This rejection is respectfully traversed. Geiger does not disclose:

"said pallet defining a vertical surface for fixing a workpiece, so that said workpiece which is fixed on said pallet vertical surface, said pallet vertical surface, and said table or pallet mount are positioned in front of said spindle along said horizontal axis, in this order from said spindle, when said machine tool machines a workpiece fixed on said pallet vertical surface"

Claim 1 stands rejected under 35 USC 102(b) as anticipated by Selander (US 4090287). This rejection is respectfully traversed. Selander does not disclose:

"said pallet defining a vertical surface for fixing a workpiece, so that said workpiece which is fixed on said pallet vertical surface, said pallet vertical surface, and said table or pallet mount are positioned in front of said spindle along said horizontal axis, in this order from said spindle, when said machine tool machines a workpiece fixed on said pallet vertical surface"

For all of the above-recited reasons, the standing rejections against claims 1- 2 should each now be withdrawn and the application passed to issue.

No additional fees are believed to be required. In the event that an additional fee is required with respect to this communication, the Commissioner is hereby authorized to charge any additional fees, or credit any overpayment, to Paul & Paul Deposit Account No. 16-0750. (order no. 5989)

Respectfully submitted,
Paul & Paul

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